



Patent  
Attorney's Docket No. 032221-008

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	
HANNU TÄHKÄNEN	)	Group Art Unit: 3653
Application No.: 09/719,229	)	Examiner: Donald P. Walsh
Filed: February 9, 2001	)	Confirmation No.: 7229
For: A CHIP SCREENING METHOD	)	
AND PLANT	)	

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Response to Restriction Requirement is in complete response to the Official Action mailed on July 28, 2004.

The Examiner has required that the present application be restricted, under 35 U.S.C. §§ 121 and 372, to one of the following three groups of claims:

- ♦ **Species I:** claims 7 and 10 directed to a rotatable device with a plurality of sections to adjust a rate of rotation to control an amount of dosed chips.
- ♦ **Species II:** claims 8, 9, 11 and 12 directed to two conveyors where a ratio of chips carried on a first is diverted and carried to a second conveyor.

Applicant hereby elects, with traverse, the invention defined by the Examiner as Species I, which includes claims 7 and 10. For the reasons set forth below, Applicant requests that the restriction requirement be modified so that Species I and II be examined together.

The restriction is traversed. Applicant respectfully notes that during review by the International Searching Authority (ISA), the claims of the PCT application did not receive a lack of unity rejection. Because unity of invention was found for the PCT application under PCT Rule 13, Applicant submits that the current restriction requirement is improper.

In Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks, 231 U.S.P.Q. 590, 590-1 (E.D. Va 1986), the Court held that a restriction requirement of claims found to have unity runs afoul of Article 27. Article 27 provides in part:

(1) No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

Thus, analogous to the facts of Caterpillar, as this application was filed under 35 U.S.C. § 371 and the claims were found to have unity by the International Searching Authority, the U.S. Patent and Trademark Office cannot not now require a restriction. Requiring a restriction would run afoul of Article 27. Accordingly, Applicants request that the claims of Species II be rejoined with the claims of Species I.

Further, Applicant asserts that the subject matter of all claims is closely related, and thus it would not be a serious burden on the Examiner to examine the complete subject matter of the claims together. In light of the close relationship between the subject matter of all claims, it is believed that a complete search for the subject matter disclosed in all the claims would overlap. Thus, it would not be a serious burden on the Examiner to examine all the matter disclosed in the claims at this time. Therefore, withdrawal of the restriction requirement and favorable consideration of all the claims of record on the merits are respectfully requested.

In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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Date: August 24, 2004

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